REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-4, 6-7, 11, 13 and 22 are pending in this application. Claims 1, 6 and 7 are amended, and claims 5 and 23-31 have been cancelled. Claim 1 is the independent claim.

Applicants respectfully note that the present action does not indicate that the claim to foreign priority under 35 U.S.C. §119 has been acknowledged or that certified copies of all priority documents have been received by the U.S.P.T.O. Applicants respectfully request that the Examiner's next communication include an indication as to the claim to foreign priority under 35 U.S.C. §119 and an acknowledgement of receipt of the certified copies of all priority documents.

Rejections under 35 U.S.C. § 112

Claims 23-31 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection for the reasons detailed below.

Claims 23-31 have been canceled. Applicants thus respectfully submit that the rejection of claims 23-31 under 35 U.S.C. §112, first paragraph, has been rendered moot by the claim amendment.

The Applicants, therefore, respectfully request that the rejection to Claims 23-31 under 35 U.S.C § 112, first paragraph, be withdrawn.

Rejections under 35 U.S.C. § 103

Lyu in view of Toray

Claims 1-7, 11, 13 and 22-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,623,711 to Lyu et al. (hereinafter "Lyu") in view of JP 2002-107932 to Toray Ind. Inc., (hereinafter "Toray"). Applicants respectfully traverse this rejection for the reasons detailed below.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

The combination of Lyu and Toray does not disclose or teach the composition for forming a porous dielectric film claimed in Claim 1, and therefore fails to teach all elements of the instant claims, and further, fails to provide a suggestion or incentive that would lead one skilled in the art to use a acid generator or a base generator disclosed therein to provide a composition for forming a porous dielectric film.

Toray merely discloses a radiation-sensitive composition comprising a siloxane polymer which has a substituent containing fluoride and a base generator which generates base by the exposure of radiation. Toray neither discloses nor suggests a composition for forming a porous dielectric film, comprising: (i) a siloxane-based resin precursor; (ii) a condensation catalyst

generator; (iii) a pore-generating material; and (iv) a solvent for dissolving the components (i)-(iii), wherein the siloxane-based resin precursor is prepared by hydrolysis and polycondensation of at least one cyclic siloxane based monomer selected from the group consisting of compounds represented by Formula 1 and at least one silane-based monomer selected from the group consisting of compounds represented by Formulae 2 to 4 using an acid or base catalyst and water in an organic solvent.

Toray's radiation sensitive composition is used for high-resolution resist, which is removed from a substrate after a desired pattern is formed in a lithography process. Applicants submit that one skilled in the art would not be motivated to apply the teachings of Toray to the composition for forming a porous dielectric film of the claimed invention. Since the resist film is removed in the process of lithography, one skilled in the art would not try to improve the dielectric constant of a resist film. Further, if pores are present in a resist film, they may cause problems, such as diffused reflection and/or expansion of a resist pattern. Thus, one skilled in the art would not be motivated to add a pore-generating material in a resist material that may cause potential problems. There is nothing in the combination that would lead one skilled in the art to combine Lyu and Toray with a reasonable expectation that the combination would provide the unexpected results disclosed in the instant specification. In addition to the disparity in the fields of endeavor, there is no suggestion in Lyu and Toray that would lead one skilled in the art to assume that a acid generator or a base generator of Toray, disclosed to have desirable performance in an

resist composition, would be suitable as a replacement for the preferred condensation catalyst generator of a composition for forming a porous dielectric film of Lyu.

"A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does." *Id.* There is no suggestion or incentive provided in the Office action that would lead one skilled in the art to so modify the combination of Lyu and Toray to include a condensation catalyst generator of Formula (8) and a pore-generating material a composition for forming a porous dielectric film, or with an expectation for success for the modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification'") (citation omitted); *In re Stencel*, 828 F.2d 751, 755, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987) (obviousness cannot be established "by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made").

Claims 2-4, 6-7, 11, 13 and 22, dependent on independent claim 1, are patentable for the reasons stated above with respect to claim 1 as well as for their own merits. Claims 5 and 23-31 have been cancelled, and therefore, the rejection of claims 5 and 23-31 is now moot.

The Applicants, therefore, respectfully request that the rejection to Claims 1-7, 11, 13 and 22-31 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

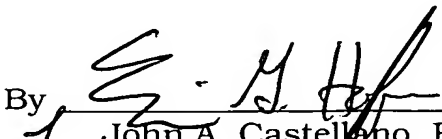
Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required $130.00 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Erin G. Hoffman, Reg. No. 57,752, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By 

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